

**Remarks**

Applicant submits this response to the Examiner's Office Action of July 8, 2009. The period for response extends through January 8, 2010 with a petition for a three-month extension of time and payment of the required fee. The Office Action has been carefully reviewed and the following remarks are made in response thereto.

In view of the following remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

**II. Response to the Office Action**

**2. Claim Rejections under 35 U.S.C. §103(a)**

**a. Kodama *et al.* and Creffield *et al.***

Claims 1, 10, 11, 14 and 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama (US 5,747,519) in view of Creffield (The International Research Group on Wood Preservation, 12-17 May 2002). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable.

The Examiner acknowledges that Kodama does not explicitly teach the claimed bifenthrin retention rate. The Examiner attempts to cure this deficiency by citing Creffield.

Creffield discloses a bifenthrin formulation wherein white spirit is used as the solvent. White spirit is an organic solvent. In other words, it is not water. More specifically, white spirit is a paraffin-derived clear, transparent liquid used in painting and decorating. It is a mixture of saturated aliphatic and alicyclic C7 to C12 hydrocarbons with a maximum content of 25% of C7 to C12 alkyl aromatic hydrocarbons.

In marked contrast to what is disclosed in the cited references, the claimed invention requires that the bifenthrin be diluted in water. The penetration characteristics of organic solvents into wood compared to the penetration characteristics of water into wood are completely different. Combining Kodama with Creffield does not yield the claimed invention because the retention rates required by the claims are in the context of bifenthrin diluted in water. Thus, a person having ordinary skill in the art would not arrive at the claimed invention by combining Kodama and Creffield. Withdrawal of the rejection is respectfully requested.

**b.     *Wimmer et al. and Creffield et al.***

Claims 1, 10, 11, 14 and 20-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wimmer (CA 2 321 353) in view of Creffield (The International Research Group on Wood Preservation, 12-17 May 2002). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable.

The Examiner acknowledges that Wimmer does not explicitly teach the claimed bifenthrin retention rate. The Examiner attempts to cure this deficiency by citing Creffield.

As stated above, Creffield discloses a bifenthrin formulation wherein white spirit is used as the solvent. White spirit is an organic solvent. In other words, it is not water. More specifically, white spirit is a paraffin-derived clear, transparent liquid used in painting and decorating. It is a mixture of saturated aliphatic and alicyclic C7 to C12 hydrocarbons with a maximum content of 25% of C7 to C12 alkyl aromatic hydrocarbons.

In marked contrast to what is disclosed in the cited references, the claimed invention requires that the bifenthrin be diluted in water. The penetration characteristics of

organic solvents into wood compared to the penetration characteristics of water into wood are completely different. Combining Wimmer with Creffield does not yield the claimed invention because the retention rates required by the claims are in the context of bifenthrin diluted in water. Thus, a person having ordinary skill in the art would not arrive at the claimed invention by combining Wimmer and Creffield. Withdrawal of the rejection is respectfully requested.

**c. Takahide *et al.*, Wimmer *et al.* and Creffield *et al.***

Claims 1, 10, 11, 14 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahide *et al.* (JP 11-207706; machine-generated translation referred to herein and attached herein), in view of Wimmer *et al.* (CA 2 321 353) and Creffield *et al.* (The International Research Group on Wood Preservation, 12-17 May 2002). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention unpatentable.

The Examiner acknowledges that both Takahide and Wimmer do not explicitly teach the claimed bifenthrin retention rate. The Examiner attempts to cure this deficiency by citing Creffield.

As stated above, Creffield discloses a bifenthrin formulation wherein white spirit is used as the solvent. White spirit is an organic solvent. In other words, it is not water. More specifically, white spirit is a paraffin-derived clear, transparent liquid used in painting and decorating. It is a mixture of saturated aliphatic and alicyclic C7 to C12 hydrocarbons with a maximum content of 25% of C7 to C12 alkyl aromatic hydrocarbons.

In marked contrast to what is disclosed in the cited references, the claimed invention requires that the bifenthrin be diluted in water. The penetration characteristics of organic solvents into wood compared to the penetration characteristics of water into wood are completely different. Combining Takahide and Wimmer with Creffield does not yield the claimed invention because the retention rates required by the claims are in the context of bifenthrin diluted in water. Thus, a person having ordinary skill in the art would not arrive at the claimed invention by combining Takahide and Wimmer and Creffield. Withdrawal of the rejection is respectfully requested.

**d.     Shires *et al.* and Wimmer *et al.***

Claims 1, 7, 10, 11, 14, 15, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shires *et al.* (The International Research Group on Wood Preservation, 19-24 May 1996) in view of Wimmer *et al.* (CA 2 321 353). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable.

The Examiner acknowledges that the Shires reference does not teach the water diluted bifenthrin composition being applied by spraying at a retention rate between about 4 and 23 grams per cubic meter of wood as instantly claimed. Wimmer does not cure this deficiency because no retention rates are disclosed. Withdrawal of the rejection is respectfully requested.

**e. Jaetsch *et al.*, Wimmer *et al.* and Creffield *et al.*.**

Claims 1, 10, 11, 14 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaetsch *et al.* (EP 1 018 413) in view of Wimmer *et al.* (CA 2 321 353) and Creffield *et al.* (The International Research Group on Wood Preservation, 12-17 May 2002). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention unpatentable.

The Examiner acknowledges that Jaetsch does not teach the aqueous bifenthrin composition being applied to the wood by spraying at a retention rate of between about 4 and 23 grams per cubic meter. The Examiner also acknowledged that Wimmer does not teach the rate at which bifenthrin is applied. Creffield does not cure these deficiencies.

As stated above, Creffield discloses a bifenthrin formulation wherein white spirit is used as the solvent. White spirit is an organic solvent. In other words, it is not water. More specifically, white spirit is a paraffin-derived clear, transparent liquid used in painting and decorating. It is a mixture of saturated aliphatic and alicyclic C7 to C12 hydrocarbons with a maximum content of 25% of C7 to C12 alkyl aromatic hydrocarbons.

In marked contrast to what is disclosed in the cited references, the claimed invention requires that the bifenthrin be diluted in water. The penetration characteristics of organic solvents into wood compared to the penetration characteristics of water into wood are completely different. Combining Jaetsch with Creffield does not yield the claimed invention because the retention rates required by the claims are in the context of bifenthrin diluted in water. Thus, a person having ordinary skill in the art would not arrive at the claimed invention by combining Jaetsch and Creffield. Withdrawal of the rejection is respectfully requested.

**f. Yu and Creffield *et al.***

Claims 1, 10, 11, 14 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu (US 5,536,305) in view of Creffield et al. (The International Research Group on Wood Preservation, 12-17 May 2002). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable.

The Examiner acknowledges that Yu does not teach the rate at which bifenthrin is applied for wood treatment. Creffield does not cure these deficiencies.

As stated above, Creffield discloses a bifenthrin formulation wherein white spirit is used as the solvent. White spirit is an organic solvent. In other words, it is not water. More specifically, white spirit is a paraffin-derived clear, transparent liquid used in painting and decorating. It is a mixture of saturated aliphatic and alicyclic C7 to C12 hydrocarbons with a maximum content of 25% of C7 to C12 alkyl aromatic hydrocarbons.

In marked contrast to what is disclosed in the cited references, the claimed invention requires that the bifenthrin be diluted in water. The penetration characteristics of organic solvents into wood compared to the penetration characteristics of water into wood are completely different. Combining Yu with Creffield does not yield the claimed invention because the retention rates required by the claims are in the context of bifenthrin diluted in water. Thus, a person having ordinary skill in the art would not arrive at the claimed invention by combining Yu and Creffield. Withdrawal of the rejection is respectfully requested.

- g. Kodama et al. in view of Creffield et al.; Wimmer et al. in view of Creffield et al.; Shires et al. in view of Wimmer et al.; and Yu in view of Creffield et al. in view of Heitmanek**

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al. in view of Creffield et al.; Wimmer et al. in view of Creffield et al.; Shires et al. in view of Wimmer et al.; and Yu in view of Creffield et al.; as discussed above, and further in view of Heitmanek (US 4,894,262). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable.

Applicants comments with respect to Kodama, Creffield, Shires, Wimmer and Yu are incorporated herein by reference. Heitmanek do not cure any of the deficiencies of these references, most importantly because the claimed retention rates are not taught or suggested. Withdrawal of the rejection is respectfully requested.

- h. Kodama et al. in view of Creffield et al.; Wimmer et al. in view of Creffield et al.; Takahide et al. in view of Wimmer and Creffield et al.; Shires et al. in view of Wimmer et al.; Jaetsch et al. in view of Wimmer et al. and Creffield et al.;and Yu in view of Creffield et al. as discussed above and further in view of Ricahardson (Wood preservation 1993).**

Claim 8 stands rejected as allegedly being unpatentable over Kodama et al. in view of Creffield et al.; Wimmer et al. in view of Creffield et al.; Takahide et al. in view of Wimmer and Creffield et al.; Shires et al. in view of Wimmer et al.; Jaetsch et al. in view of Wimmer et al. and Creffield et al.;and Yu in view of Creffield et al. as discussed above and

further in view of Ricahardson (Wood preservation 1993). Applicants respectfully traverse the rejection because the combination of references does not render the claimed invention upatentable

Applicants comments with respect to Kodama, Creffield, Wimmer, Takahide Shires, Jaetsch, and Yu are incorporated herein by reference. Richardson does not cure any of the deficiencies of these references, most importantly because the claimed retention rates are not taught or suggested. Withdrawal of the rejection is respectfully requested.



**III. Conclusion.**

Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 38184.04113US. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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